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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,566	09/14/2001	Naoki Tsuchiya	Q66152	8705

7590

11/05/2002

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 11/05/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-21 are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-21 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/936,566

## DETAILED ACTION

Claims 1-21 are pending in the application.

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g. A, M, B, E, G, J, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

**Group I.** Claims 1, 3, 4, 6-15, and 17-21 (in-part), drawn to products wherein A is a pyridine ring, J is a substituted or unsubstituted C<sub>1-6</sub> normal, cyclic or branched alkyl group, E is COOR<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

**Group II.** Claims 1, 2, 4, 6-15, and 17-21 (in-part), drawn to products wherein A is a benzene ring, J is a substituted or unsubstituted

C<sub>1-6</sub> normal, cyclic or branched alkyl group, E is COOR<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

**Group III.** Claims 1, and 3-21 (in-part), drawn to products wherein A is a pyridine ring, J is an aryl, E is COOR<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

→ **Group IV.** Claims 1, 2, and 4-21 (in-part), drawn to products wherein A is a benzene ring, J is an aryl, E is COOR<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

**Group V.** Claims 1, 3, 4, 6-8, 10-15, 17, and 19-21 (in-part), drawn to products wherein A is a pyridine ring, J is a substituted or unsubstituted C<sub>1-6</sub> normal, cyclic or branched alkyl group, E is SO<sub>3</sub>R<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

**Group VI.** Claims 1, 2, 4, 6-8, 10-15, 17, and 19-21 (in-part), drawn to products wherein A is a benzene ring, J is a substituted or unsubstituted C<sub>1-6</sub> normal, cyclic or branched alkyl group, E is SO<sub>3</sub>R<sup>4</sup> and M is sulfur, sulfonyl or sulfonyl.

**Group VII.** Claims 1, 3-8, 10-17, and 19-21 (in-part), drawn to products wherein **A** is a pyridine ring, **J** is an aryl, **E** is  $\text{SO}_3\text{R}^4$  and **M** is sulfur, sulfonyl or sulfonyl.

**Group VIII.** Claims 1, 2, 4-8, 10-17 and 19-21 (in-part), drawn to products wherein **A** is a benzene ring, **J** is an aryl, **E** is  $\text{SO}_3\text{R}^4$  and **M** is sulfur, sulfonyl or sulfonyl.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and the examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant

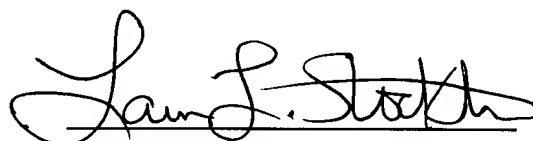
structural element qualifying as the special technical feature that defines a contribution over the prior art. The products claimed contain a fused imidazole ring which does not define a contribution over the prior art. The substituents on the fused imidazole structure vary extensively and when taken as a whole result in vastly different products. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

November 4, 2002